

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through 05/31/2008. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)			
<div>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</div> <div>on <u>07/09/2008</u></div> <div>Signature <u>Janice Chen</u></div> <div>Typed or printed name <u>Janice Chen</u></div>		MTKP0032USA			
		<table border="1" style="width: 100%; border-collapse: collapse;"><tr><td style="width: 50%; padding: 5px;">Application Number <div style="text-align: center;">10/604,862</div></td><td style="width: 50%; padding: 5px;">Filed <div style="text-align: center;">08/22/2003</div></td></tr></table>		Application Number <div style="text-align: center;">10/604,862</div>	Filed <div style="text-align: center;">08/22/2003</div>
		Application Number <div style="text-align: center;">10/604,862</div>	Filed <div style="text-align: center;">08/22/2003</div>		
		First Named Inventor <div style="text-align: center;">Ming-Yang Chao</div>			
<table border="1" style="width: 100%; border-collapse: collapse;"><tr><td style="width: 50%; padding: 5px;">Art Unit <div style="text-align: center;">2627</div></td><td style="width: 50%; padding: 5px;">Examiner <div style="text-align: center;">Gupta, Parul H</div></td></tr></table>		Art Unit <div style="text-align: center;">2627</div>	Examiner <div style="text-align: center;">Gupta, Parul H</div>		
Art Unit <div style="text-align: center;">2627</div>	Examiner <div style="text-align: center;">Gupta, Parul H</div>				
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <div style="display: flex; justify-content: space-between; align-items: flex-start; margin-top: 20px;"><div style="width: 45%;"><p>I am the</p><div style="margin-bottom: 10px;"><input type="checkbox"/> applicant/inventor.</div><div style="margin-bottom: 10px;"><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</div><div style="margin-bottom: 10px;"><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>41,526</u></div><div><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</div></div><div style="width: 45%; text-align: center;"><div style="margin-bottom: 10px;"> _____ Signature</div><div style="margin-bottom: 10px;">Winston Hsu _____ Typed or printed name</div><div style="margin-bottom: 10px;">302-729-1562 _____ Telephone number</div><div>07/09/2008 _____ Date</div></div></div> <p style="font-size: small; margin-top: 20px;">NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>					
<div style="display: flex; align-items: center;"><input style="margin-right: 10px;" type="checkbox"/> *Total of _____ forms are submitted.</div>					

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

HIGH-SPEED OPTICAL RECORDING APPARATUS

Appl. No. : 10/604,862 Confirmation No. : 1861
Applicant : Ming-Yang Chao
Filed : August 22, 2003
TC/A.U. : 2627
Examiner : Gupta, Parul H
Docket No. : MTKP0032USA
Customer No. : 27765

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Reconsideration and allowance of claims 1, 4-14, 18, 40, and 43-47 is
5 respectfully requested because the independent claims 1 and 40 have been rejected
based on an improper standard. Specifically, the Examiner's rejection of independent
claims 1 and 40, in addition to other dependent claims, does not sufficiently teach all
of the limitations of the claims. According to MPEP 2143.03 "All words in a claim
must be considered in judging the patentability of that claim against the prior art".

10

Concerning independent claim 1:

Claim 1 recites that a clock generator generates distinct first and second clock
signals. Claim 1 also states that a delay adjustment state machine generates a rough
15 delay parameter and a fine delay parameter according to the selected set of write
strategy parameters, and delays the RLL modulation waveform according to the
second clock signal and the set of write strategy parameters so as to generate a second
delay signal.

20 In contrast, the cited prior art fails to disclose the delay adjustment state machine

“delaying the RLL modulation waveform according to the second clock signal and the set of write strategy parameters so as to generate a second delay signal”.

As evidenced by the most recent Office action dated March 10, 2008, the Examiner’s position is that:

- a) The delay adjustment state machine is part of element 114 (Fig. 2 of Kaku).
- b) The second clock signal refers to SCLK and is transferred to the delay adjustment state machine through the “internal data bus” shown in Fig. 2 of Kaku.
- c) The delay adjustment state machine delays the RLL modulation waveform according to the second clock and the set of write strategy parameters (Column 2, lines 38-40 of Kaku).

However,

- a) Kaku fails to disclose that the “internal data bus” transfers the clock signal SCLK into the write strategy control unit 104. As one can see, Kaku only illustrates the internal data bus in Fig. 2, but fails to provide more detailed descriptions, such as, what the structure of the bus is and how the bus operates. Therefore, one of skilled in the art cannot realize how the “SCLK is transferred to the delay adjustment state machine through the internal data bus”.
- b) Further, Kaku fails to disclose the delay adjustment state machine delays the RLL modulation waveform according to the second clock and the set of write strategy parameters. The cited paragraph (col. 2, lines 38-40) only disclose “For this the delay circuit is provided for the purpose of bring the NRZ modulation signal from the modulation circuit into line with the reflection light in timing thereof”. From this one skilled in the art cannot realize how the teaching of this paragraph has a relationship with “the delay adjustment state machine”, and further has the relationship with the delay adjustment state machine “delaying the RLL modulation waveform according to the second clock and the set of write strategy parameters”.

In the Response to Arguments written on page 12 of the Office action dated 03/10/2008, the Examiner has stated that “Applicant argues that Kaku et al. does not teach that the internal data bus transfers the clock signal to the write strategy control unit. However, as the data utilizes this clock (it is the only one feeding into element 5 100) the data bus also carries the same clock signal.”

The applicant respectfully submits that the examiner is reading too much into the disclosure of Kaku, and that Kaku’s disclosure does not teach or suggest how “the data utilizes the clock”. Since the second clock does not enter the write strategy unit 10 104, the write strategy unit 104 does not have the ability to delay the RLL modulation waveform according to the second clock signal.

Therefore, the applicant submits that claim 1 is patentable over the combination of Kaku and Kato for the reasons given above. Furthermore, as claims 4-14, 18, and 15 43-47 are dependent on claim 4-14, 18, and 43-47 should be allowed if claim 1 is allowed.

Concerning independent claim 40:

20 Claim 40 recites the limitation of “wherein the fine delay chain is not connected to and does not utilize a clock signal for delaying the first delay signal to generate the write signal.”

The fine delay chain is utilized to process “the first delay signal”. Before the first 25 delay signal is processed by the fine delay chain, the first delay signal might be generated associating with a clock signal. However, when the fine delay chain delays the first delay signal, it is not needed to connect and utilize a clock signal. Thus, one skilled in the art would not interpret that the fine delay chain, as shown in Figs. 2 and 3 of the instant application, delays **the first delay signal** by utilizing a clock signal.

30

The Examiner has stated at the end of page 12 of the Office action dated 03/10/2008, “However, by not utilizing a clock signal in the generation of the delay

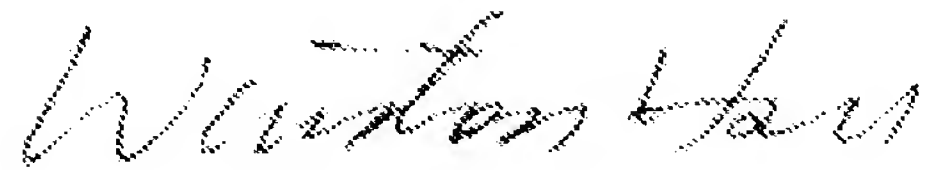
parameters, Kato et al. does not utilize a clock signal in delaying the first delay. If no clock signal was utilized in generating a delay parameter, no clock signal can be utilized while the parameter is implemented.”

5 However, Kato teaches in column 5, lines 50-53 that the fine delay 234 “**be clocked** so as to produce a different delay”. Also, Figure 3 teaches that the clock signals ($4f_{\text{EFM } \Phi 0-\Phi 7}$) are sent to the fine delay 324 to be used as an input for creating a delay with the fine delay 324. Therefore, for the above reasons, the applicant respectfully submits that claim 40 is patentable over the combination of Kaku and
10 Kato.

Conclusion:

Thus, the applicant submits that all pending claims are in condition for allowance with respect to the cited art for at least the reasons presented above. A pre-appeal brief
15 conference to review the above arguments is respectfully requested.

Sincerely yours,

20 

Date: 07/09/2008

Winston Hsu, Patent Agent No. 41,526

P.O. BOX 506, Merrifield, VA 22116, U.S.A.

Voice Mail: 302-729-1562

Facsimile: 806-498-6673

25 e-mail : winstonhsu@naipo.com

Note: Please leave a message in my voice mail if you need to talk to me. (The time in D.C. is 12 hours behind the Taiwan time, i.e. 9 AM in D.C. = 9 PM in Taiwan.)